

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
Tuqiang NI *et al.* : Confirmation No. 5171
U.S. Patent Application No. 09/821,753 : Group Art Unit: 1763
Filed: March 30, 2001 : Examiner: Luz L. Alejandro Mulero

For: PLASMA PROCESSING METHOD AND APPARATUS WITH CONTROL OF
PLASMA EXCITATION POWER

**APPELLANTS' MOTION TO STRIKE MAY 5, 2009 COMMUNICATION ENTITLED
EXAMINER'S ANSWER**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Patent and Trademark Office sent attorney for appellants a paper entitled "Examiner's Answer" on May 5, 2009. The transmittal sheet accompanying this paper states there is an attachment in the form of a supplemental examiner's answer in response to the appeal brief filed January 22, 2008, and July 9, 2008, and the reply brief filed January 13, 2009. Based on the foregoing, the May 5, 2009 paper should have been designated a supplemental examiner's answer and appellants will treat it as such.

Appellants submit this motion to strike the May 5, 2009, paper because the paper does not comply with MPEP Section 1207.05 entitled "Supplemental Examiner's Answer." MPEP Section 1207.05I. states: "In response to a reply brief filed in compliance with 37 CFR 41.41, the primary examiner may: (A) withdraw the final rejection and reopen prosecution (see MPEP Section 1207.04); or (B) provide a supplemental examiner's answer responding to any new issue raised in the reply brief. The examiner can not issue a supplemental examiner's answer if the reply brief raised no new issue." The May 5, 2009, communication (1) makes no allegation of appellants' reply brief raising a new issue and (2) does not include a withdrawal of the final rejection and reopening of prosecution.

The reply brief does not raise new issues; it points out inadequacies in the original examiner's answer and why there are incorrect rationales in the answer for (1) the new ground of rejection and (2) the new arguments raised in the original examiner's answer.

Pages 1-10 and page 11 to the paragraph beginning at the bottom of page 11 of the supplemental examiner's answer are verbatim copies of the November 13, 2008, original examiner's answer. Page 13, line 3 through the end of the supplemental answer are verbatim copies of the original answer beginning at the last three lines of page 15 through the end of the original answer. These sections of the supplemental answer even repeat, from the original answer, (1) errors of syntax, (2) incorrectly located commas and (3) the statement "inventor Andrew D. Bailey, Ph D.", which inaccurately implies Doctor Bailey is an inventor of this application. Hence, pages 1-10 and page 11 to the paragraph beginning at the bottom of page 11 and page 13, line 3 through the end of the supplemental answer do not comply with MPEP Section 1207.05I because they do not consider new issues raised in appellants' reply brief.

The consideration of claim 59 in the paragraph bridging pages 11 and 12 of the supplemental answer is not in response to a new issue raised in the reply brief. Instead, it is a response to the first full sentence on page 2 of the reply brief; this sentence indicates the new ground of rejection in the original examiner's answer was defective because it did not address the requirements of claim 59. Hence the discussion of claim 59 in the supplemental answer is not in conformance with MPEP Section 1207.05I.

The three full paragraphs on page 12 of the supplemental answer do not refer to any particular claims. They are generalizations that are applicable to any of the claims rejected on Chao et al., regardless of whether those claims were rejected in the final rejection or the new grounds of rejection. These arguments are a rehash of the arguments set forth in the original examiner's answer. The paragraph bridging pages 12 and 13 of the supplemental answer deals with "housekeeping" matters. Thus the four paragraphs beginning on page 12 of the supplemental answer do not respond to new issues raised in the reply brief and therefore do not conform with MPEP Section

1205.07I.

The issues raised in the first full paragraph on page 12 of the supplemental examiner's answer were considered in appellants' original brief at the only full paragraph on page 15. Hence this paragraph does not respond to new issues raised in the reply brief and therefore does not conform with MPEP Section 1205.07I.

The issues raised in the second full paragraph on page 12 of the supplemental examiner's answer were considered in appellants' original brief at the last two paragraphs on page 13 and the second paragraph on page 14 and the only full paragraph on page 15. Hence this paragraph does not respond to new issues raised in the reply brief and therefore does not conform with MPEP Section 1205.07I.

The last full paragraph on page 12 of the supplemental examiner's answer repeats the arguments set forth on page 8 of the original examiner's answer and which are considered in appellants' original brief in the paragraph bridging pages 14 and 15 and on pages 21-23. Hence this paragraph does not respond to new issues raised in the reply brief and therefore does not conform with MPEP Section 1205.07I.

The examiner's failure to identify new arguments in appellant's reply brief is an indication that appellants did not advance new arguments in the reply brief. MPEP Section 1207.05I implies the examiner has the burden of showing that appellants raised new arguments in the reply brief. Appellants reply to the new grounds of rejection set forth in the original answer was essentially a repeat of the arguments appellants set forth in their original brief concerning the rejection in the final rejection of claims 38-46 based on Chao et al.. Because the Rules of Practice and Board decisions indicate an appellant concedes to the position of the examiner if the appellant does not respond to all issues and rejections raised by the examiner, appellants felt compelled to essentially repeat these arguments in the reply brief in connection with the new ground of rejection based on Chao et al. against claims 47-66.

Granting of the motion is in order.

If the motion is not granted, appellants are filing concurrently with this motion a supplemental reply brief to the supplemental answer. However if the motion is granted, the Board need not consider either the supplemental answer or the supplemental reply brief.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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